UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES E. SCHINNER, BRAD BEALL, and JERRY R. POTTS

Appeal No. 2005-2252
Application No. 09/676,649

ON BRIEF

Before GROSS, MACDONALD, and NAPPI, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-2 and 4-25. Claim 3 has been canceled.

Invention

Appellants' invention relates to a camera and method for utilizing an improved algorithm for determining and indicating to a user the number of pictures that can still be taken with the camera and recorded in the internal or removable memory of the

camera. The improved algorithm uses the actual image file size of an image file just generated by the camera to determine the number of pictures that can still be taken.

Claim 1 is representative of the claimed invention and is reproduced as follows:

> 1. A digital still camera, comprising:
>
> an image sensor mounted in a housing for receiving light and generating output signals representative of an image of an object or a scene of interest;
>
> a processing circuit mounted in the housing and connected to the image sensor for processing the output signals from the image sensor;
>
> a memory mounted in the housing;
>
> a control circuit mounted in the housing and connected to the processing circuit for successively generating a plurality of image files corresponding to a plurality of images and storing the image files in the memory in accordance with a selected one of a plurality of picture modes, the control circuit determining a remaining picture count after each image file is generated based on a predetermined decrement number corresponding to an actual image file size of each image file; and
>
> means mounted in the housing for indicating the remaining picture count to a user.

References

The references relied on by the Examiner are as follows:

Uehara	5,481,303	Jan. 2, 1996
Shen et al. (Shen)	6,122,411	Sep. 19, 2000
Roberts et al. (Roberts)	6,233,010	May. 15, 2001
		(Filed February 19, 1999)

Moore	6,282,605	Aug. 28, 2001 (Filed April 26, 1999)
Wong et al. (Wong)	US2003/0058355	Mar. 27, 2003 (Filed September 23, 1998)
Haruki	6,603,509	Aug. 5, 2003 (Filed June 8, 1998)
Koide et al. (Koide)	6,433,820	Aug. 13, 2002 (Filed April 28, 1998)

Rejections At Issue

Claims 1-2, 4, 6, 8, 11-14, 16, 18, and 20-21 stand rejected under 35 U.S.C. § 102 as being anticipated by Shen.

Claim 5 stands rejected under 35 U.S.C. § 103 as being obvious over Shen.

Claims 7, 9-10, 17, and 19 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Shen and Uehara.

Claim 15 stands rejected under 35 U.S.C. § 103 as being obvious over the combination of Shen and Wong.

Claims 22-23 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Shen and Moore.

Claim 24 stands rejected under 35 U.S.C. § 103 as being obvious over the combination of Shen and Roberts.

Claim 25 stands rejected under 35 U.S.C. § 103 as being obvious over the combination of Shen and Haruki.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.[1]

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated **infra**, we reverse the Examiner's rejection of claims 1-2, 4, 6, 8, 11-14, 16, 18, and 20-21 under 35 U.S.C. § 102; and we reverse the Examiner's rejection of claims 5, 7, 9-10, 15, 17, 19, and 22-25 under 35 U.S.C. § 103.

I. Whether the Rejection of Claims 1-2, 4, 6, 8, 11-14, 16, 18, and 20-21 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Shen does not fully meet the invention as recited in claims 1-2, 4, 6, 8, 11-14, 16, 18, and 20-21. Accordingly, we reverse.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v.**

[1] Appellants filed an appeal brief on October 7, 2004. Appellants filed a reply brief on March 17, 2005. The Examiner mailed an Examiner's Answer on January 26, 2005.

American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 1, Appellants argue at page 6 of the brief, that Shen fails to describe "actual image file size" as one skilled in the art would understand that term reading Appellants' specification at page 12. We agree. Appellants point out that the "actual image file size" is "the size of the image file just generated" by the camera.

At page 16 of the answer, the Examiner argues that "actual image file size" should be interpreted broadly so as to include a predetermined standard image file size for low (or high) resolution pictures as taught by Shen. We see no basis in the record for such an interpretation.

The Examiner also argues that the predetermined number of Shen is the same as the actual file size of the image that would be generated by the camera. We see no evidence in the record nor has the Examiner shown in Shen that the "predetermined standard image file size" selected before the image is generated always corresponds to the size of the image file that is later generated by the camera. In fact, Appellants' specification at lines 3-18 of page 2 discusses why this is not the case.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

II. Whether the Rejection of Claims 5, 7, 9-10, 15, 17, 19, and 22-25 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 5, 7, 9-10, 15, 17, 19, and 22-25. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a ***prima facie*** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **In re Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444 (Fed. Cir. 1992).

See also In re Piasecki, 745 F.2d at 1472, 223 USPQ at 788 (Fed. Cir. 1984).

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **In re Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444 (Fed. Cir. 1992). "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to dependent claims 5, 7, 9-10, 15, 17, 19, and 22-25, we note that the Examiner has relied on the references solely to teach limitations found in the dependent claims. Each reference in combination with Shen (or Shen alone) fails to cure the deficiencies of Shen noted above with respect to claim 1.

Therefore, we will not sustain the Examiner's rejections under 35 U.S.C. § 103 for the same reasons as set forth above.

Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 102 of claims 1-2, 4, 6, 8, 11-14, 16, 18, and 20-21; and we have not sustained the rejection under 35 U.S.C. § 103 of claims 5, 7, 9-10, 15, 17, 19, and 22-25.

REVERSED

ANITA PELLMAN GROSS
Administrative Patent Judge)
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ALLEN R. MACDONALD) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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